

REMARKS

Claims 1-288 are pending in the present application. Claims 1 and 145 are independent claims, and each is amended. The Examiner's consideration of the present remarks along with the previously submitted remarks is respectfully requested.

35 U.S.C. § 103 Rejection

Claims 1-288 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Suzuki et al.* (U.S. Patent No. 6,213,652) in view of *Goertz et al.* (U.S. Patent No. 6,173,295), and in view of *Guck* (U.S. Patent No. 5,911,776), and further in view of *Shimizu et al.* (U.S. 5,943,680). This rejection is respectfully traversed.

While not conceding the appropriateness of the Examiner's rejection, but merely to advance prosecution of the instant application, independent claims 1 and 145 are amended herein to recite combinations of elements directed to a system for delivering documents across a network providing a single integrated solution to deliver a document to one or more different destinations or recipients in a single steps, regardless of an end from which the document is presented.

Support system for "delivering documents across a network providing a single integrated solution to deliver a document to one or more different destinations or recipients in a single steps, regardless of an end from which the

document is presented” can be found in the specification, for example on page 1, line 36 to page 2, line 6.

The Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness in the rejection of independent claims 1 and 145 under 35 U.S.C 103(a), since there is no hint whatsoever in any of the references that one with ordinary skill in the art would combine the teachings of the references, including *Suzuki et al.*, *Goertz et al.*, *Guck*, and *Shimizu et al.*, to arrive at the single integrated solution, as set forth in independent claims 1 and 145 of the present invention.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The Examiner has failed to establish that one skilled in the art would have been motivated to combine the cited references or that one skilled in the art would have faced the same problem faced by the Applicants. The Applicants alone recognized the problem in the conversion and were alone motivated to create “a single integrated solution which allows a network user to deliver his or

her documents to one or more different destinations or recipients in a single step regardless of the end form in which the document is presented" (page 1, line 36 – page 2, line 6). In this sense the system supports any output device such as: standard image forming devices, fax devices, email communications, data communication links and archiving devices (page 3, lines 31-33). It was the Applicants alone who realized this ideal of a single integrated solution supporting the whole variety of output devices.

In contrast to the presently claimed invention, none of the documents cited by the Examiner provide a hint to come to such a single integrated solution as claimed. In none of the documents can a reason be found to combine the documents to come to a system according to the invention. In this case, it is observed is that also the discovery of the problem by the Applicants that is relevant. The existence of the problem was not disclosed in any of the cited references. Thus, if one of ordinary skill in the art is unaware of the problem, there is no reason, no motivation to solve the problem, and thus no motivation to combine the cited reference documents to come to the subject matter of the application.

Numerous cases have determined that the mere fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness, and also have determined that the mere fact that the claimed invention is within

the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness. Examples cited in the MPEP 2143 include:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In *re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir 1990). Although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.” 916 F.2d 682, 16 USPQ2d at 1432.

Further, a statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” “because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

In another case, *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000), the Court reversed an obviousness rejection involving technologically simple concept because there was no finding as to the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention.

Further, the Applicants respectfully submit that when one recognizes that a problem exists in the prior art, and thereafter, solves that problem, that the Applicants are entitled to a patent when the prior art fails to teach or suggest the solution thereof.

For example, as stated by Judge Johnson in In re Shaffer, 108 USPQ 326 (CCPA 1956):

"It is too well settled for citation that references may be combined for the purpose of showing that a claim is unpatentable. However, they may not be combined indiscriminately, and to determine whether the combination of references is proper, the following criterion is often used: namely, whether the prior art suggests doing what an applicant has done ... Furthermore, when references are combined to negate patentability, it should also be considered whether one skilled in the art with the references before him could have made the combination of elements claimed without the exercise of invention ... The foregoing cases, in our opinion, stand for the proposition that it is not enough for a valid rejection to view the prior art in retrospect once an applicant's disclosure is known. The art applied should be viewed by itself to see if it fairly disclosed doing what an applicant has done. If the art did not do so, the references may have been improperly combined."

In view of the amendments, arguments, and case citations set forth above, the Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness by combining *Suzuki et al.*, *Goertz et al.*, *Guck*, and *Shimizu et al.*

Therefore the rejection of independent claims 1 and 145 is improper and should be withdrawn. All claims of the present application should now be in condition for allowance.

CONCLUSION

For the foregoing reasons, Applicants respectfully request the Examiner to reconsider and withdraw the rejections of record, and earnestly solicit an early issuance of a Notice of Allowance.

Should there be any matters which need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number of the undersigned below.

Pursuant to the provisions of 37 C.F.R. §§ 1.17 and 1.136(a), the Applicant respectfully petitions for a three (3) month extension of time for filing a response in connection with the present application and the required fee of \$475.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies, to charge payment or credit any overpayment to Deposit

U.S. Appln. No. 09/175,905
Amendment filed on February 27, 2004
Reply to Office Action dated August 28, 2003

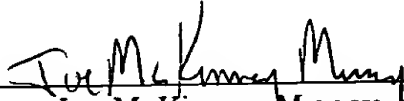
Attorney Docket No. 0142-0317P
Art Unit: 2176
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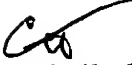
Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or
under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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